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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,121	10/26/2001	Petr Peterka	018926-006510US	2113
20350	7590	06/21/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,121

Applicant(s)

PETERKA ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) see att.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. In response to communications filed on 4/29/2003, applicant pre-amends claim 1. The following claims 1-26 are presented for examination.

Claim Objections

2. **Claim 24** is objected to because of the following informalities: in order to avoid rendering the claim indefinite, the term "said program material" should be changed to --said program content--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.1 **Claims 1-15, 18, and 23** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication US 2002/0002674 to **Grimes et al.**

As per claims 1, 4, 6, 10, and 23, **Grimes et al** discloses a method for distributing program content in a network, comprising of a plurality of servers (page 3, paragraph 31) and some servers can be used as secondary storage or back up or redundant servers for storing information (page 3, paragraphs 33 and 36) that meets the recitation of a caching server operable for storing a copy of said program content said network comprising a server for providing said program content, a client operable for communicating with said server across said network, (page 3, paragraph 29); and discloses using a profile that contains user information for user access that defines rules of whether said client is entitled to receive said program content (page 4, paragraphs 39-40 42 and page 5, paragraph 44) and a hardware profile associated with user ID that further limits the user's authorization as to which machine is authorized to view the content (page 7, paragraph 60) that meets the recitation of allowing said client to request said program content from said network; **Grimes et al** discloses receiving a data record for said client for use in determining whether said client is entitled to said program content (page 4, paragraph 43); receiving a rule associated with said program content for use by said caching server so as to determine whether said client is entitled to said program content (page 4, paragraphs 39-41);

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Grimes et al discloses using a hardware profile or pc profile to compare rule to a record describing at least one entitlement characteristic of said client so as to determine whether said client is entitled to receive said program content (page 4, paragraphs 39-40) before distributing a key to said client for decrypting said program content (page 4, paragraphs 43-44 and page 5, paragraph 48); and multicasting said program content through use of said caching server (page 4, paragraph 44).

As per claims 2-3, Grimes et al discloses the limitation of wherein said rule is comprised of a method of payment and discloses wherein said rule is comprised of a subscription identifier (page 5, paragraph 44).

As per claim 5, Grimes et al discloses the limitation of wherein said rule is comprised of a restriction based on a content rating for a user (page 4, paragraph 44).

As per claim 7, Grimes et al discloses using program ID that determines information indicating at least one service subscribed to by said client (page 4, paragraph 44).

As per claim 8, Grimes et al discloses using certificate that meets the recitation of wherein said at least one entitlement characteristic comprises data for use in authenticating said client with said caching server (page 4, paragraphs 43-44 and page 5, paragraph 48).

As per claim 9, Grimes et al discloses using profile that meets the recitation of wherein said at least one entitlement characteristic is stored by said client in a ticket (page paragraph 42).

As per claims 11-12, Grimes et al discloses further comprising encrypting said at least one entitlement characteristic so as to prevent said client from altering said at least one entitlement characteristic (page 5, paragraph 49).

As per claim 13, Grimes et al discloses the limitation of wherein said multicasting said program content is begun before said comparing said rule to said record (page 5, paragraph 47).

Claim 14 is similar to claim 1 except for stating formatting a data record comprising an identifier to identify said program content and said rule for said program content. Grimes et al discloses formatting a profile comprising program ID and program type to identify the rule and program content and a digital certificate including the program ID (page 5, paragraph 44). Therefore, claim 14 is rejected on the same rationale as the rejection of claim 1.

As per claims 15 and 18, Grimes et al discloses the limitation of authenticating said data record and conveying said data record to said client (page 5, paragraph 41).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 16-17, 19-22 and 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 2002/0002674 to **Grimes et al** in view of US Patent 6,385,596 to **Wiser et al**.

4.2 **As per claims 16-17 and 19-22, and 24-26, Grimes et al** substantially discloses the claimed method of claim 14. **Grimes et al discloses** the limitation of conveying said program material to said client (page 5, paragraph 44 and 47) and discloses a trusted third party creating an encrypted digital certificate providing a key to the server for certificate validation process; decrypting said data record with a key received from a trusted third party, wherein said trusted third party is a trusted third party for said caching server and said server, wherein said receiving said data record for said client comprises: receiving said data record from said client (page 4, paragraphs 41 43). **Grimes et al** discloses the use of certificate but does not explicitly teach the use of digital signature which is well known in the art to authenticate a document. **Wiser et al** in an analogous art discloses an online distribution system in which a trusted third party digitally signs a consumer certificate and issues it to the user for subsequent transactions (column 25, lines

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12-35 and column 13, lines 35-67) and further discloses conveying the consumer certificate to a content manager server and delivery server for authentication, conveying an identifier identifying said program content from said client to said caching server; authenticating said data record at said caching server; and allowing said caching server to determine whether said client is entitled to receive said program (column 4, lines 11-41). **Wiser et al** discloses at least a media license server as a trusted third party for a content manager server and a delivery server and discloses distributing public/private keys to the content manager server for certificate validation that involves (column 24, lines 55-65 see also a publishing embodiment column 11, line 63 through column 12, line 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cryptographic protocol used in **Grimes et al** to also include the use of a digital signature to sign the record so that it can be authenticated by another server that delivers the content to make sure that record is from the right user authorized to use the content and was issued by a trusted server as taught by **Wiser et al** (column 4, lines 27-67). One skilled in the art would have been motivated to make such a modification because the digital signature in combination with the certificate and the identifiers and confidential information in the passport helps to validate both the integrity of the transaction and the parties involved thereby making the transaction more secure.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses some of the claimed features of a multicast distribution system.

US Patents: 6,067,623 Blakley, III et al; 5,758,068 Brandt et al.

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5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cc

Carl Colin

Patent Examiner

June 15, 2005


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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